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**REISSUE LITIGATION**

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**In re Reissue Patent Application  
For PATENT NO. 5,711,100**

**WILLIAM A. ELMER**

**Serial No. 74,598**

**Filing Date: June 14, 1993**

**For: VEHICLE ADVERTISING  
SIGN, SYSTEM AND  
METHOD**

**DECLARATION OF  
JAMES W. CAULK**

*Reissue file: 10/098648*

I, James W. Caulk, declare as follows:

1. I am over the age of 18 and am competent to testify. The matters set forth herein are based upon my own personal knowledge.
2. I am a resident of the state of Florida.
3. I am the owner and President of Mr. Bill's International, Inc. (Mr. Bill's) located at 1413-15 Bryant Street, Leesburg, Florida.
4. Mr. Bill's has been a supplier of magnetic car top vehicle advertising signs since 1987. (See Exhibit A)
5. One of my company's first products was the Twirl N. Ad which was a magnetic car top vehicle advertising sign that utilized an RB-80 magnet. This advertising sign was made

**DECLARATION OF JAMES W. / BILL CAULK - 1**

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of plastic and the base of the sign was affixed to the vehicle utilizing round-based "RB-80" magnets. The stock "RB-80 magnet" is more fully detailed below. I filed a patent for this magnetic vehicle advertising sign design on July 17, 1987 and was issued U.S. Patent No. D305,778 on January 30, 1990. (See Exhibit B)

6. Mr. Bill's began promoting and selling its "Drive-N-Ad" product in 1990. This car top vehicle advertising sign has a base and sides that come together to form a hollow bodied device. There are no ends to the car top vehicle advertising sign. (See Exhibit C and Exhibit A)

7. Mr. Bill's "Drive-N-Ad" product affixes the sign to the top of the vehicle by using an "RB-80 magnet." The RB-80 magnet is a catalog magnet assembly manufactured by several different companies, for example Adams Manufacturing. (See Exhibit D: Invoice to Mr. Bill's for RB-80 magnet assemblies from Adams Manufacturing dated 05/03/91)

8. The 1991 invoice attached as Exhibit D for my company's purchase of the stock RB-80 magnet assemblies are the magnet assemblies used in our Drive-N-Ad signs as further reflected in the Drive-N-Ad purchase invoice, dated December 20, 1991. (See Exhibit E.)

9. The stock RB-80 magnet assemblies were attached to the "Drive-N-Ad" by utilizing flexible rubber grommets that allowed a range of motion so that the magnets could conform to the top of the car. This concept is what Mr. Bill's promoted as its "floating magnet."

"Drive-N-Ad uses a new floating magnet technique that safely secures this powerful traveling billboard to any vehicle with an unencumbered steel roof." (See Exhibit F and Exhibit G )

Exhibit F outlines testimonials, one from Judge Jack Singbush, regarding his use of the Drive-N-Ad "floating" magnetic car top sign during his campaign in 1990. Exhibit G is a letter from Judge Singbush, dated September 6, 1990, in regards to his successful use of the magnetic car top sign.

10. I am very familiar with products supplied to the pizza industry, and have personal knowledge regarding the concepts, functions, and designs of car top vehicle advertising signs.

11. I have reviewed and am familiar with the design, specifications, and drawings of U.S. Patent No. 5,711, 100 issued to Mr. William Elmer on January 27, 1998. (See Exhibit H) I am also familiar with Mr. Elmer's products distributed through his company, HTH, Inc.

12. The stock catalog RB-80 magnet assembly is the same magnet assembly as described by William Elmer is his Patent No. 5, 711, 100 and was not invented by Mr. William Elmer. (See Exhibit H)

13. Mr. Bill's flexible rubber grommet (i.e. "floating magnet") provided the same functionality as what has been called the "flexible sleeve" in U.S. Patent No. 5, 711, 100. Mr. Bill's product was being manufactured, advertised, and sold long before Mr. Elmer's patent application for U.S. Patent No. 5, 711,100, yet he failed to advise the patent office of these particular aspects of my company's products.

14. Mr. Bill's flexible rubber grommet (i.e. "floating magnet") was being used on the Drive N. Ad products specifically sold to the pizza industry, which industry Mr. Bill's became a supplier to in 1991. This is the same industry that Mr. Elmer and his company HTH supplies to.

15. In 1991, I inquired into the patentability of my Drive-N-Ad sign utilizing this "floating magnet" (i.e. flexible sleeve/flexible rubber grommet concept) with a patent attorney who advised as follows:

\_\_\_\_\_  
"In accordance with your request, an investigation as to the patentability of the subject invention was made during my recent visit to the United States Patent and Trademark Office in Washington, D.C."

....  
"Of the patents reviewed with respect to the subject invention, the following appear to represent the most pertinent prior art. Copies of these references are enclosed:

Patent No. 2,957,261:	Inventor Moskowitz
Patent No. 2,960,788:	Inventor Wagner
Patent No. 3,148,856	Inventor Orlando

Patent No. 3,440,748  
Patent No. 4,287,676

Inventor Hackley  
Inventor Weinhaus

“This search was directed towards a sign for the top of a vehicle which is attached to the top without the use of straps y using floating magnets which attach to the curvature of the roof of a vehicle which magnets are anchored in metal cups which are attached with rubber grommets to the framework for supporting the sign. “

The letter then goes on to speak to the patented prior art that already utilizes this flexible sleeve/flexible rubber grommet invention to allow the magnets to conform to the curvature of the vehicles. (See Exhibit I) In short, I was advised that patentability, if at all available based upon the prior art, would provide very little protection. Nonetheless, we applied for a patent and received U.S. Patent No. D386, 091 for my “Drive- N- Ad” design that utilizes a magnet with a flexible rubber grommet; i.e. the “floating magnet” concept. (See Exhibit J)

16. From my ordinary experience and understanding in this area, it is my opinion that Mr. Elmer should have disclosed the above referenced prior art, including disclosure of the relevant aspects of my company’s product, during the application process for U.S. Patent No. 5, 711, 100.

17. Mr. Elmer had knowledge of my company’s products because I had a meeting with Mr. William Elmer and his wife at their place of business, HTH in Florida in 1991. I went to meet with the Elmer’s to show them my product, and specifically to show them my “floating magnet” technique. My purpose for meeting with them was to see if we could strike up some sort of business relationship whereby we worked together to manufacture these signs. They indicated that they would get back to me.

18. I recall some time later that either a Mr. Tim Lynch, an employee of Mr. Elmer’s company HTH, or Mr. Elmer’s son came into my place of business asking about our product and

showing an interest in how it was manufactured and designed; and specifically about the magnets and the flexible way they were attached.

19. After several months went by without any additional communication from Mr. Elmer, I was put on notice that Mr. Elmer's company, HTH began manufacturing a sign utilizing this flexible design/"floating magnet" concept for the magnets. I looked at one of the signs and then saw that a patent was pending on Mr. Elmer's product even though my company was already manufacturing, selling and designing my products well prior to the time he filed his application on June 14, 1993. In my opinion, we was seeking a patent based upon my prior product.

20. My company's magnetic Drive-N-Ad product, with the R-80 magnet assembly and flexible sleeve/flexible grommet concept, was designed, manufactured, advertised, and sold prior to Mr. Elmer's filing of his application for U.S. Patent No. 5, 711, 100, and are products that should have been disclosed to the USPTO in careful detail for consideration when reviewing Mr. Elmer's application, and which the USPTO should now consider in light of Mr. Elmer's reissue application serial number 74,598. This is especially true in light of the patent appearing to reflect that Mr. Elmer claims to have invented a magnet that in fact is a stock catalog RB-80 type magnet that was not invented by Mr. Elmer and because it appears that he also claims to have invented the concept of this flexible sleeve/flexible rubber grommet concept that in fact has prior art that predates his application.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct:

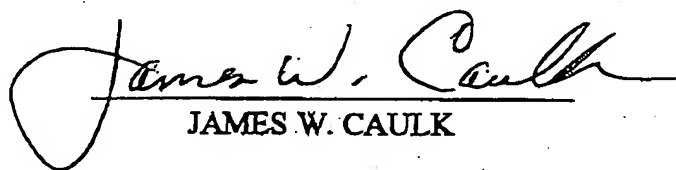
EXECUTED this \_\_\_\_\_ day of October, 2002 at \_\_\_\_\_.

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JAMES W. CAULK

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct:

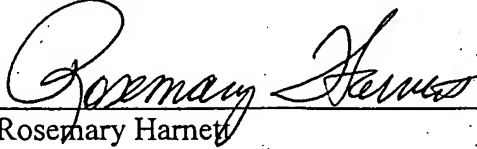
EXECUTED this 30<sup>th</sup> day of October, 2002 at \_\_\_\_\_.

  
JAMES W. CAULK

CERTIFICATE OF MAILING

I hereby certify that this DECLARATION OF JAMES W. CAULK is being deposited with the United States Postal Service as Express Mail on the 1<sup>st</sup> day of November, 2002, in an envelope addressed to the following:

- and
- (1) The Assistant Commissioner for Patents, BOX DAC, Washington, D.C. 20231,
  - (2) Mr. Herbert L. Allen, Allen, Dyer, Doppelt, Franjola & Milbrath, P.A.  
255 South Orange Avenue, Suite 1401, Orlando, FL 32802-3791  
Attorneys for William A. Elmer, Applicant

  
\_\_\_\_\_  
Rosemary Harnett